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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,151	04/09/2001	Alan Young	47185-95330	8242
5073	7590	10/23/2006	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				NGUYEN, TAN D
		ART UNIT		PAPER NUMBER
		3629		

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,151	YOUNG, ALAN	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7,9 and 10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7, 9-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/06 has been entered.

Response to Amendment

2. The amendment filed 8/10/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claim 1, the amended language of "electronically determining the value of the key" is new matter. The examiner has searched through the speciation but cannot find the support for this language.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Status

Claims 1-7 (method), 9 (system), 10 (apparatus) are active and are rejected as followed. Claim 8 has been canceled.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-7, 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

In the present case, **method claims 1-7** is directed to a “method for reporting a value of a key performance indicator”, which is not within one of the classes of invention set forth in § 101.

The “method for reporting a value of a key performance indicator” comprising the steps of:

- (a) identifying a key performance indicator (KPI),
- (b) identifying at least one business event associated with the (KPI)
- (c) receiving a business event message ... ,
- (d) determine the value of the (KPI) based on the business data, and
- (e) displaying the determined value of the (KPI) via a contextual visualization interface”,

are merely a disembodied abstract idea and do not produce a (1) useful and (2) tangible, and (3) concrete result. The result of the instant invention is one or more

numbers (value) displayed on a contextual visualization interface. The number (value) might be considered “useful” in reporting a key performance indicator (prediction). However, § 101, 2nd test requires that the result be reproducible or repeatable to meet the tangible and concrete requirement. See *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Circuit 2000). In the instant case, it’s not clear how the most important step “determining the value of the key performance indicator based on the business data” is carried out? There is no citation in the specification of how this step is carried out and no example has been cited. Applicant’s response of 10/12/05, on page 7, that this step “*may be performed in any appropriate manner*”. In other word, the step of “determining the value” is subjective and can be carried out any way or step, depending on each circumstance, which indicates that the value is changeable, unpredictable or irreproducible, varying depends on event, event message, occurrence, system, person, etc. The claim is broad to include determining by human being which produces results which are subjective and irreproducible. This fails to meet the test that the result has to be concrete to meet the § 101 test. Moreover, there is no physical transformation of anything to another state or thing even though this is dispositive. Therefore, claims 1-7 are thus drawn to the abstract idea of identifying an indicator and determining the value of the indicator and displaying it on a medium, rather than to a practical application of the idea as required by 35 U.S.C. § 101.

System claim 9 is directed to a “system for reporting a value” comprising mainly software, which is not within one of the classes of invention set forth in § 101 (i.e. (1) a

process/method, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for reporting a value, does not reasonably provide enablement for (d) determining the value of the key performance indicator (KPI), based on the business data above. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Pages 17-18 and Fig. 3 have been reviewed but there is no citation of how to carry out step (d) or any example of how the value can be determined. Moreover, What is the relationship of these variables: (1) business event, (2) business event message and (3) an occurrence of the business event to the step of "determining the value of the KPI" or in other word, are these variables being used in determining the value of the KPI? Again, there is no demonstration or example of how these variables related to the determining

of the KPI. Note that in a method claim, elements or steps are normally related or congruent and can not be presence in the claim and hanging loose.

8. In claims 1, 9 and 10, it's not clear how the step of "determine the value of the key performance indicator based on the business data" is carried out or how the value is obtained since "based on the business data" and related to the previous step with respect to "occurrence" is not clear and definite. The mere change from "the occurrence" to "an occurrence" does not resolve the rejections above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries (4) set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill (artisan) in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness/unexpected.

11. Claims 1-7 (method), 9 (system) and 10 (apparatus) are rejected under 35 U.S.C. 103(a) as being unpatentable over COOK (US Patent 6,546,378).

As of 8/10/2006, claim 1 is as followed:

1. (Currently amended) A method for reporting a value of a key performance indicator comprising:

- receiving information identifying a key performance indicator to monitor;
- identifying at least one business event associated with the selected key performance indicator;
- receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event;
- in response to receiving the business event message electronically determining the value of the key performance indicator based on the business data; and
- displaying the determined value of the key performance indicator via a contextual visualization interface.

As for independent method claim 1, COOK discloses a method for reporting (or displaying) a value of a key performance indicator (prediction), comprising:

- a) identifying a key performance indicator (or KPI) (prediction) {col. 39, example 3, "stock market prediction", i.e. stock price prediction};
- b) identifying at least one business event associated with the KPI (prediction) {see col. 39, lines 34-67}

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c) receiving a business event message (data) indicating the occurrence of the business event and describing the business event {see col. 39, line 43 col. 40, line 4; d) determining the value of the KPI (prediction) based on the business data {see col. 40, lines 4-48, steps 4-9}; and e) displaying the determined value of the KPI (prediction) via a contextual visualization interface (monitor/screen display) {see Fig.1, element 42 (computer display screen), or element 44 (printer)} {also, see example 3 on cols. 39-40, or example 11 on col. 45, for teachings of steps (a)-(e) above with other prediction dealing with weather forecast such as whether it will rain in San Francisco in two days}. COOK fairly teaches the claimed invention except for some relationship between the occurrence of event and the message (data). However, on example 12, step 7 on col. 40 (or similar teachings on col. 46, step 8), COOK fairly teaches the determination of the relationship between different types of events (occurrence) or the determination of different maps to predicted different features of IBM stock for different periods into the future using different collections of market measures and by analyzing wave packets of different lengths, therefore, it would have been obvious to a skilled artisan in the data analysis and management to link business event message indicating the occurrence of the business event to the determination of the value of the prediction if desired, as fairly taught in COOK above.

As for dep. claims 2-6 (part of 1 above), which deals with well known data event parameters, i.e. different type of event features such as reference, change, threshold event, task completion or failure, etc., these are non-essential to the scope of the

claimed invention which is "data analysis and management" and are fairly taught in example 12, col. 46, "... *relationship between different types of events*".

As for dep. claim 7 (part of 1 above), which further limits the KPI, a prediction and the determining step using a predictive logic, these are taught in Examples 3 or 11 above and col. 13, lines 1-5.

As for independent apparatus claims 9 and 10, which are merely software system and apparatus to carry out the method of claim 1 above, they are rejected over the system/apparatus to carry out the method of claim 1 as rejected above and further in view of system/apparatus disclosed Fig. 1 (10) or col. 10, lines 27-67.

12. Claims 1-7 (method), 9 (system) and 10 (apparatus) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over MORGAN et al.

As for independent method claim 1, MORGAN et al discloses a method for reporting (or displaying) a value of a key performance indicator (trend, forecast, benchmark), comprising:

- a) receiving information identifying a key performance indicator (or KPI) (Fig. 1, 34, 36, 38, Fig. 7, 116, 122, 124);
- b) identifying at least one business event associated with the KPI (prediction) {see Fig. 1, col. 5, lines 15-30}
- c) receiving a business event message (data) indicating the occurrence of the business event and describing the business event {Table A and B on col. 9};
- d) determining the value of the KPI (prediction) based on the business data {see Table D or I, or J, col. 16, Fig. 1, 17}; and

e) displaying the determined value of the KPI (prediction) via a contextual visualization interface (monitor/screen display) {see Fig.1, element 40, Fig. 2, element 72, 50}. MORGAN et al fairly teaches the claimed invention except for some relationship between the occurrence of event and the message (data). However, on col. 5, lines 25-35, col. 7, lines 15-38, col. 8, lines 32-52, Fig. 10, MORGAN et al fairly teaches the determination of the relationship between different types of events (occurrence) or the determination of different ways to predict different values, it would have been obvious to a skilled artisan in the data analysis and management to link business event message indicating the occurrence of the business event to the determination of the value of the prediction if desired, as fairly taught in MORGAN et al above.

As for dep. claims 2-6 (part of 1 above), which deals with well known data event parameters, i.e. different type of event features such as reference, change, threshold event, task completion or failure, etc., these are non-essential to the scope of the claimed invention which is “data analysis and management” and are fairly taught in col. 5, lines 20-60.

As for dep. claim 7 (part of 1 above), which further limits the KPI, a prediction and the determining step using a predictive logic, these are taught in Fig. 1, element 50, col. 4, lines 8-12.

As for independent apparatus claims 9 and 10, which are merely system/apparatus to carry out the method of claim 1 above, they are rejected over the

system/apparatus of MORGAN et al to carry out the method of claim 1 as rejected above and further in view of system/apparatus disclosed Fig. 1 or 2.

Response to Arguments

13. Applicant's main arguments (3) filed 8/10/06 with respect to the examiner's rejections have been fully considered but they are not persuasive.

(1) As for the 101 rejections, applicant's comment that applicant's amendment of 8/10/06 has addressed the examiner's concern is not persuasive. The amendment fails to overcome the issues of the rejections as indicated above.

14. (2) Applicant's comment with respect to the 112, 2nd paragraph rejections have been reviewed but not persuasive. The paragraph shown on pp. 8-9 of the application with the non-limiting example has been reviewed but these are insufficient to overcome the rejections, as addressed above. No specific example has been shown and this does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Pages 17-18 and Fig. 3 have been reviewed but there is no citation of how to carry out step (d) or any example of how the value can be determined. Moreover, What is the relationship of these variables: (1) business event, (2) business event message and (3) an occurrence of the business event to the step of "determining the value of the KPI" or in other word, are these variables being used in determining the value of the KPI? Again, there is no demonstration or example of how these variables related to the determining of the KPI. Note that in a method claim, elements or steps are normally related or congruent and can not be presence in the claim and hanging loose.

(3) Applicant's comment with respect to the 103 rejections are not persuasive in view of the paragraph no. 9 cited above which discloses the location of teachings of steps (a)–(e) in COOK, especially as cited in example 3, cols. 39–40, and examples 11 and 12, cols. 45–46.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See US Patent 5,889,993; 5,832,467; US 2001/0001149 and 2003/0055759 for similar teachings with respect to data analysis and management including the step of calculating a predicting value or future value (future trend) based on historical data.

See US 2001/0047274 for activities-based business modeling with business data inputs to determine future trends or forecast.

No claims are allowed.

Art Unit: 3629

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892; etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtm
October 3, 2006



DEAN T. NGUYEN
PRIMARY EXAMINER